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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,012	10/07/2003	Michael Furst	FURST, M-1	4718
25889	7590	03/15/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,012	<b>Applicant(s)</b> FURST, MICHAEL	
	<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-31 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-31 is/are rejected.
- 7)  Claim(s) \_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

*u*

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-7, 9-14 and 22-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe (US 4,396,665).

Rowe discloses a film-bitumen combination comprising at least three layers (Figure 1) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 1, #2 and #3). Regarding claim 2, the at least two film layers have different coefficients of thermal expansion (see col. 5, lines 41-46 and 63-68). Regarding claim 3, note at least one of the at least two film layers is produced from a polyolefin (see col. 4, line 5). Regarding claim 4, note at least one of the at least two film layers is produced from polypropylene (see col. 4, lines 4-5). Regarding claim 5, note at least one of the at least two film layers is produced from polyamide (see col. 4, line 5). Regarding claim 6, note at least one of the at least two film layers is produced from polyethylene terephthalate (see col. 4, line 6). Regarding claim 7, the PET layer is oriented (see col. 4, lines 36-37). Regarding claim 9, the at least two film layers (Fig. 1, #2 and #3) are laminated to a bituminous layer (Fig. 1, #1) individually or together (see col. 2, lines 39-45). Regarding claim 10, the bituminous layer (Fig. 1, #1) is coated on the at least two film layers

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(Fig. 1, #2 and #3). Regarding claim 11, note at least one film layer (Fig. 1, #2) facing the bituminous layer provides a mineral oil barrier (see col. 5, lines 20-25). Regarding claim 12, note at least one edge of part of the at least two film layers (Fig. 2, #2 and #3) projects beyond the bituminous layer (Fig. 2, #1). Regarding claims 13 and 14, the at least one edge of part of the at least two film layers (Fig. 4, #6) is shorter than the bituminous layer (Fig. 4, #1) and is on the layers facing away from the bituminous layer. Regarding claim 22, note each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 6, lines 4-27). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 63-68). Regarding claim 24, note an adhesive disposed between two adjacent layers of the at least two film layers (see col. 6, lines 50-56). Regarding claim 25, note further a barrier layer against mineral oils, oxygen or UV radiation disposed between two adjacent layers of the at least two film layers (see col. 3, lines 62-67 and col. 4, lines 16-19). Regarding claim 26, the barrier layer comprises a layer of lacquer (see col. 3, lines 64-67). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 1, #3) and a second film layer (Fig. 1, #2), the first film layer (Fig. 1, #3) being located further away from the bituminous layer (Fig. 1, #1) and having a larger coefficient of elongation than the second film layer (see col. 6, lines 64-67). Regarding claim 28, the bituminous layer (Fig. 1, #1) has a surface facing away from the at least two film layers (Fig. 1, #2 and #3) and a release liner is provided on the surface (Fig. 1, #4; also see col. 2, lines 56-62). Regarding claims 29 and 30, the release liner comprises release paper coated with silicone (see col. 2, lines 56-58).

3. **Claims 1-3, 8-11, 22, 23 and 27-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Stierli (US 4,442,148).

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Stierli discloses a film-bitumen combination comprising at least three layers (Figure 1) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 1, #2 and #3). Regarding claim 2, at least two film layers inherently have different coefficients of thermal expansion since they are both made from different materials (see col. 3, lines 66-67 and col. 4, lines 10-15). Regarding claim 3, note at least one of the at least two film layers is produced from a polyolefin (see col. 3, lines 66-67). Regarding claim 8, note at least one of the at least two film layers is produced from polyacrylonitrile (see col. 4, line 11). Regarding claim 9, note at least two film layers (Fig. 1, #2 and #3) are laminated to a bituminous layer (Fig. 1, #1) individually or together. Regarding claim 10, note the bituminous layer is coated on the at least two film layers (see col. 4, lines 52-55). Regarding claim 11, note at least one film layer (Fig. 1, #2) facing the bituminous layer provides a mineral oil barrier (see col. 4, lines 6-9). Regarding claim 22, each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 4, line 65 to col. 5, line 6). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 1-6). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 1, #3) and a second film layer (Fig. 1, #2), the first film layer (Fig. 1, #3) being located further away from the bituminous layer (Fig. 1, #1) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 3, lines 66-67 and col. 4, lines 10-15). Regarding claim 28, the bituminous layer (Fig. 1, #1) has a surface facing away from the at least two film layers (Fig. 1, #2 and #3) and a release liner is provided on the surface (Fig. 1, #4; also see col. 4, lines 28-31). Regarding claims 29 and 30, the release liner comprises release paper coated with silicone (see col. 4, lines 28-31).

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4. **Claims 1-3, 5-7, 9-11 and 22-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (US 5,824,401).

Jenkins et al. discloses a film-bitumen combination comprising at least three layers (Figure 1) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 1, #18 and #20). Regarding claim 2, the at least two film layers inherently have different coefficients of thermal expansion since both are made from different materials (see col. 4, lines 8-10 and 62-65). Regarding claim 3, at least one of the at least two film layers is produced from a polyolefin (see col. 4, lines 8-10). Regarding claim 5, at least one of the at least two film layers is produced from polyamide (see col. 4, line 63). Regarding claims 6 and 7, at least one of the at least two film layers is produced from polyethylene terephthalate and is oriented (see col. 4, lines 63-64). Regarding claim 9, the at least two film layers (Fig. 1, #18 and #20) are laminated to a bituminous layer (Fig. 1, #12) individually or together (see col. 3, lines 25-30). Regarding claim 10, the bituminous layer (Fig. 1, #12) is coated on the at least two film layers (see col. 6, lines 10-12). Regarding claim 11, at least one film layer (Fig. 1, #20) facing the bituminous layer provides a mineral oil barrier (see col. 4, lines 58-61). Regarding claim 22, each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 5, lines 20-27). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 20-27). Regarding claim 24, note a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (see col. 5, lines 39-42). Regarding claim 25, note further a barrier layer against mineral oils, oxygen or UV radiation disposed between two adjacent layers of the at least two film layers (see col. 4, lines 47-56). Regarding claim 26, the barrier layer comprises a layer of lacquer (see

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col. 4, lines 62-66). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 1, #18) and a second film layer (Fig. 1, #20), the first film layer (Fig. 1, #18) being located further away from the bituminous layer (Fig. 1, #12) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 4, lines 8-10 and col. 4, lines 62-65).

5. **Claims 1-11, 15, 16, 18 and 20-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Wiercinski et al. (US 5,687,517).

Wiercinski et al. discloses a film-bitumen combination comprising at least three layers (Figure 2) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 2, #22 and #22A and see col. 6, lines 58-64). Regarding claim 2, the at least two film layers inherently have different coefficients of thermal expansion since both are made up of different materials (see col. 3, lines 49-53 and col. 6, lines 61-64). Regarding claim 3, note at least one of the at least two film layers is produced from a polyolefin (see col. 6, lines 7-12). Regarding claim 4, note at least one of the at least two film layers is produced from polypropylene (see col. 6, line 10). Regarding claim 5, note at least one of the at least two film layers is produced from polyamide (see col. 6, line 10). Regarding claim 6, note at least one of the at least two film layers is produced from polyethylene terephthalate (see col. 6, line 10). Regarding claim 7, the PET layer is oriented (see col. 4, lines 62-63). Regarding claim 8, at least one of the at least two film layers is produced from polyacrylonitrile (see col. 6, line 64). Regarding claim 9, the at least two film layers (Fig. 2, #22 and #22A) are laminated to a bituminous layer (Fig. 2, #12) individually or together. Regarding claim 10, the bituminous layer (Fig. 2, #12; see col. 5, lines 58-60) is coated on the at least two film layers (Fig. 2, #22 and

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#22A). Regarding claim 11, note at least one film layer facing the bituminous layer provides a mineral oil barrier (see col. 6, lines 59-64). Regarding claim 15, a surface of a side of the combination facing away from the bituminous layer has been treated to have non-slip properties (see col. 4, lines 1-16). Regarding claim 16, the non-slip treatment is carried out by means of coating (see col. 6, lines 46-50). Regarding claim 18, the non-slip treatment is carried out by means of at least partial embossing of the surface (see col. 3, lines 62-65). Regarding claim 20, the non-slip treatment is provided by a coextruded syndiotactic polystyrene film (see col. 4, line 37). Regarding claim 21, the non-slip treatment is provided by a thermoplastic elastomer with a metallocene complex (see col. 4, line 37 and col. 6, lines 50-57). Regarding claim 22, each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 5, lines 14-17). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 14-17). Regarding claim 24, note a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (see col. 5, lines 18-19). Regarding claim 25, note a barrier layer against mineral oils disposed between two adjacent layers of the at least two film layers (see col. 6, lines 59-64). Regarding claim 26, the barrier layer comprises a layer of lacquer (see col. 6, lines 60-64). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 2, #22) and a second film layer (Fig. 2, #22A), the first film layer (Fig. 2, #22) being located further away from the bituminous layer (Fig. 2, #12) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 6, lines 6-12). Regarding claim 28, the bituminous layer (Fig. 3, #12) has a surface facing away from the at



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least two film layers (Fig. 3, #22 and #22A) and a release liner is provided on the surface (Fig. 3, #40). Regarding claims 29 and 30, the release liner is siliconized paper (see col. 3, lines 1-2).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 17 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Zickell et al. (US 4,992,315).

Wiercinski et al. discloses the film-bitumen combination as shown above. However, Wiercinski et al. fails to disclose the non-slip coating and the embossing being shorter at least along one edge of the combination. Zickell et al. teaches that it is old and well-known in the art to have an embossed non-slip film (Fig. 3, #28) being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling (see col. 4, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the non-slip coating and embossing in Wiercinski et al. to be shorter at least along one edge of the combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling.

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7. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (US 4,396,665) or Stierli (US 4,442,148) or Wiercinski et al. (US 5,687,517) in view of Kalkanoglu (US 4,757,652).

Rowe, Stierli and Wiercinski et al. each disclose the film-bitumen combination as shown above. However, each fails to disclose the release liner having several sections. Kalkanoglu teaches that it is old and well-known in the analogous art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck (see col. 1, lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the release liner in either Rowe or Stierli or Wiercinski et al. to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*CAS*

Catherine A. Simone  
Examiner  
Art Unit 1772  
March 7, 2005

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*3/10/05*